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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,897	10/25/2001	Manfred Eigen	EIGEN ET AL (DIV)	8308
7590	06/15/2004		EXAMINER	
Collard & Roe, P.C. 1077 Northern Boulevard Roslyn, NY 11576			TUNG, JOYCE	
			ART UNIT	PAPER NUMBER
			1637	
DATE MAILED: 06/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

MS

**Office Action Summary****Application No.**

10/032,897

**Applicant(s)**

EIGEN ET AL.

**Examiner**

Joyce Tung

**Art Unit**

1637

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47, 50, 53, 61-68 and 70-73 is/are pending in the application.
- 4a) Of the above claim(s) 73 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47, 50, 53, 61-62, 67-68 and 70-72 is/are allowed.
- 6) ☒ Claim(s) 63-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 73 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

The applicant's response filed March 1, 2004 has been entered. Claims 47, 50, 53, 61-68, 70-73 are pending.

1. Newly submitted claim 73 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: because the newly added claim 73 is drawn to a method for identification of a chemical substance active agent comprising step (a) incubation of the replication system with putative active agents of different concentration and step (b) detection of incorrect virus variants and therefore identification of the active agent. The method steps of claim 73 are different from the method claims 47, 50, 53, 61-62, 67-68 and 70-72. Thus, claim 73 is distinct from the invention originally claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 73 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The objection of claim 65 and 68 is withdrawn.

3. The rejection of claims 50-54, 56-57, 60-62, 66 and 72 under 35 U.S.C. 112, second paragraph is withdrawn.

4. The rejection of claims 47-68 and 70-72 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-5 and 13 of U.S. Patent No. 6,423,516 is withdrawn.

5. Claims 63-66 remain rejected under 35 U.S.C. 102(b) as being anticipated by Ikeda et al. (EP 0215 987).

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Ikeda et al. disclose a reverse transcriptase encoded by cauliflower mosaic virus, a cloned gene encoding for polypeptide having the reverse transcriptase and yeast used as a eukaryotic host (See the Abstract and pg. 11, column 19, lines 13-31).

The teachings of Ikeda et al. anticipate the limitations of claims 63-66 that an agent comprises a nucleic acid coding for a nucleic acid and a viral replication system and transformed viruses or eukaryotic cells or procaryotic cells.

The response argues that Ikeda et al. disclose an agent comprising a nucleic acid and a polypeptide encoded by the nucleic acid that is able to destabilize the viral quasi-species-distribution, but the present invention is not limited to such agent named by Ikeda et al. to destabilize the viral quasi-species-distribution but moreover to chemical substance to induce a defective replication to the virus population without stimulating the formation of resistant virus population. However, claims 63-66 are drawn to an agent comprising a nucleic acid or a nucleic acid coding for a nucleic acid obtained by reaction of nucleotides and a viral replication system. Since Ikeda et al. disclose cauliflower mosaic virus, a cloned gene encoding for polypeptide having the reverse transcriptase, the teachings of Ikeda et al. anticipate the limitations of the claims. Although the response argues the function of the agent of the instant invention, which might be different from the agent used by Ikeda et al., the functional language does not have patentable weight. Thus, the rejection is maintained.

### **Summary**

6. Claims 47, 50, 53, 61-62, 67-68 and 70-72 are allowable.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


8. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

9. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung J.T.  
June 9, 2004

  
GARY BENZION, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600  
6/10/04